

REMARKS

This is in response to the Office Action mailed on August 27, 2004. In the Office Action, claims 1-6, 11, 19, 23, and 25-28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Marsh et al. (U.S. Patent Application 2002/0112395). Claims 7, 12-14, 16, 17, 24, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. Claims 8, 9, 18, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh et al. in view of Nelson (U.S. Patent 6,185,862). Claims 10 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh et al. in view of Cosenza (U.S. Patent Application 2002/0124457). Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh et al. in view of Nelson and further in view of Consenza.

I. 35 U.S.C. § 102(e)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131; citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). Marsh et al. discloses an insect removal device including a backing, an adhesive surface, a tab and a protective cover as shown in FIG. 1. Specifically, Marsh et al. discloses that “[i]n all cases the tab is attached to the backing on the side opposite the adhesive.” (Marsh et al. p. 1, ¶ 11). To use the insect removal device disclosed in Marsh et al., the backing is folded slightly between a user’s thumb and forefinger and is placed over the tick so that the tick is within the “V” formed by the folded adhesive surface of the backing. The user continues to apply pressure to both sides of the backing, continuing to fold the device at the central folding axis against the body of the tick. The tab and the portions of the folded backing nearest the tab are then grasped and the device is pulled away from the skin. (Marsh et al. p. 1, ¶ 14).

Claim 1 requires pest removal device for removing a pest from a surface comprising an engagement side covered with an adhesive layer, a backing side positioned opposite the engagement side, and a single release tab covered with a tab liner extending from the engagement side and the backing side for removing the engagement side from the surface.

Marsh et al. does not teach or suggest a single release tab extending from the engagement side and the backing side. Marsh et al. only shows, as in FIG. 1, a tab 6 attached to and projecting from the back side of the backing 2, which as indicated in the specification, is in all cases opposite the adhesive layer. The tab 6 does not extend from the adhesive surface 4, which is the surface that engages with the insect. Therefore, claim 1, which requires the single release tab to extend from both the engagement side and the backing side, is not anticipated by Marsh et al. Claims 2-6 and 11, which depend from claim 1, included all of the elements of claim 1. Therefore, dependent claims 2-6 and 11 are also not anticipated by Marsh et al.

Claim 19 requires a pest removal device for removing a pest from a surface comprising a substrate comprising a first side and a second side, wherein the first side has an engagement portion and a single release tab portion, an adhesive layer covering the engagement portion of the first side to contact the pest, and a tab liner covering the single release tab portion of the first side.

Marsh does not disclose a pest removal device where the first side of the substrate has an engagement portion and a single release tab portion with the adhesive layer covering the engagement portion. Instead, in Marsh et al. the tab is attached to the backing and “[i]n all cases the tab is attached to the backing on the side opposite the adhesive.” Therefore, the engagement portion, covered with the adhesive layer, cannot be on the same surface as the single release tab as is required by claim 19. Because Marsh et al. does not teach or suggest having substrate comprising a first side and a second side, wherein the first side has an engagement portion and a single release tab portion and an adhesive layer covering the engagement portion, claim 19 is not anticipated by Marsh et al.

Claim 23 requires a pest removal device for removing a pest from a surface comprising a substrate comprising a first side and a second side, means for removably storing the pest removal devices, means for securing the pest to the first side of the substrate, and means for holding the pest removal device without contacting the means for securing.

Claim 23 includes means plus function elements. The application of a prior art

reference to a means plus function limitation requires that the prior art element perform the identical function specified in the claim. (See MPEP § 2182). Also, the prior art structure must be the same as or equivalent to the structure described in the specification, which has been identified as corresponding to the claimed means plus function. (MPEP § 2182).

Claim 23 is not anticipated by Marsh et al. because Marsh et al. does not disclose the structure disclosed within the specification corresponding to the means for holding the pest removal device without contacting the means for securing. As shown in FIGS. 1-6 of the application, the release tab operates to allow the user to hold the pest removal device without contacting the means for securing. The release tab shown and described in the application is a projection from the perimeter of the main body of the pest removal device.

Unlike the structure disclosed in the specification as the means for holding the pest removal device, the tab in Marsh et al. does not project from an edge or a perimeter of the insect removal device. Instead, the tab is attached to the backing on the side opposite the adhesive. Therefore, because Marsh et al. does not disclose the structure as disclosed in the specification as corresponding to the claimed means for holding the pest removal device without contacting the means for securing, claim 23 is not anticipated by Marsh et al.

Claim 25 requires a method of removing a pest from a surface comprising providing an pest removal device, wherein the pest removal device comprises an engagement side covered with an adhesive layer, a backing side positioned opposite the engagement side, and a single release tab covered with a tab liner extending from the pest removal device to remove the pest removal device from the surface, positioning the engagement side over the pest, securing the pest removal device to the pest and the surface, pulling the single release tab, and removing the pest removal device from the surface with the pest attached to the engagement side of the pest removal device.

Marsh et al. does not disclose securing the pest removal device to the pest and the surface. Instead, to use the insect removal device in Marsh et al., the user folds the backing along a central folding axis to facilitate gripping of the insect, as shown in FIG. 3. The device is placed

over the tick so that the tick is within the “V” formed by the fold. The user continues to fold the device against the body of the tick. Once captured, the user pulls the device away from the point of attachment. Marsh et al. teaches grasping the tick and not applying the adhesive surface of the device to both the pest and the surface. Marsh et al. only teaches applying the adhesive surface to the pest.

Marsh et al. does not disclose removing the pest removal device from the surface with the pest attached to the engagement side of the pest removal device, as required by claim 25. Although the insect is removed from the surface, the insect removal device is not removed from the surface because the insect removal device of Marsh et al. is never secured to the surface.

Because Marsh et al. does not disclose securing the pest removal device to the pest and the surface and also does not disclose removing the pest removal device from the surface, claim 25 is not anticipated by Marsh et al. Claims 26-29, which depend from claim 25, include all of the elements of claim 25. Therefore, because claim 25 is not anticipated by Marsh et al., dependent claims 26-29 are also not anticipated by Marsh et al.

II. 35 U.S.C. § 103(a)

The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. MPEP § 2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. MPEP § 2143.01. Second, there must be a reasonable expectation of success. MPEP § 2143.02. Third, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCAP 1974); MPEP § 2143.03.

A. Marsh et al.

Claim 7, which depends from claim 1, includes all of the limitations of claim 1. As discussed above, Marsh et al. does not disclose all of the limitations of claim 1 because Marsh et al. does not teach or suggest a single release tab covered with a tab liner extending from the engagement side and the backing side for removing the engagement side from the surface.

Therefore, even with the additional element of claim 7, not all of the claim limitations are taught or suggested by Marsh et al. such that dependent claim 7 is not made obvious by Marsh et al.

Claims 12-14, 16, and 17, all of which include the limitations of claim 12, are not made obvious by Marsh et al. Claim 12 requires a pest removal device for removing a pest from a surface comprising a main body having a length, a width, a perimeter, an engagement side covered with an adhesive layer and a backing side positioned opposite the engagement side, and a release tab extending from the perimeter of the main body, the release tab has a length parallel to the main body length and less than the main body length and a width parallel to the main body width and less than the main body width.

Marsh et al. does not disclose a release tab extending from the perimeter of the main body. The tab shown in Marsh et al. does extend from a main body of the insect removal device. However, the tab is only disclosed as extending from nearly the center of the backing, as shown in FIG. 1. The tab in Marsh et al. does not extend from the perimeter of the insect removal device because in order to properly operate the insect removal device, as disclosed, the device is folded and the tab is pulled along the fold to remove the tick. (Marsh et al, p. 1, ¶ 14). If the tab extended from the perimeter, then the user would not be able to fold and pull the tab along the fold as disclosed.

Marsh et al. does not disclose all of the limitations of claim 12 because Marsh et al. does not teach or suggest a release tab extending from the perimeter of the main body as required by claim 12. Therefore, even with the additional elements of claims 13-14, 16, and 17, not all of the claim limitations are taught or suggested by Marsh et al. such that claims 12-14, 16, and 17 are not made obvious by Marsh et al.

Claim 24 requires a pest removal device for removing a pest from a surface comprising a circular disk comprising a first surface and a second surface, wherein the first surface has an engagement portion and a single release tab portion, an adhesive layer covering the engagement portion of the first surface to contact the pest, a tab liner covering the single

release tab portion of the first surface, and a storing liner to removably secure the adhesive layer of the pest removal device.

Marsh et al. does not disclose a circular disk comprising a first surface and a second surface, wherein the first surface has both an engagement portion and a single release tab portion with the adhesive layer covering the engagement portion of the first surface. Instead, in Marsh et al. the tab is attached to the backing and “[i]n all cases the tab is attached to the backing on the side opposite the adhesive.” Therefore, the engagement portion, covered with the adhesive layer, cannot be on the same surface as the single release tab as is required by claim 24. Not all of the claim limitations are taught or suggested by Marsh et al. Because Marsh et al. does not teach or suggest having a first surface with an engagement portion and a single release tab portion, and claim 24 is not made obvious by Marsh et al.

Dependent claim 29, which includes all of the limitation of claim 25, is not made obvious by Marsh et al. As discussed above, Marsh et al. does not disclose all of the limitations of claim 25 because Marsh et al. does not teach or suggest securing the pest removal device to the pest and the surface and does not teach or suggest removing the pest removal device from the surface. Therefore, even with the additional element of claim 29, not all of the claim limitations are taught or suggested by Marsh et al. such that dependent claim 29 is not made obvious by Marsh et al.

B. Marsh et al. in view of Nelson

Claims 8 and 9, which depend from claim 1, includes all of the limitations of claim 1. As discussed above, Marsh et al. does not disclose all of the limitations of claim 1 because Marsh et al. does not teach or suggest a single release tab covered with a tab liner extending from the engagement side and the backing side for removing the engagement side from the surface. Nelson also does not teach or suggest a single release tab, but shows two release tabs. Therefore, even with the additional element of claim 8 and 9, not all of the claim limitations are taught or suggested by Marsh et al. in view of Nelson, such that dependent claims 8 and 9 are not made obvious by Marsh et al. in view of Nelson.

Dependent claim 18, which include the limitation of claim 12, is not made obvious by Marsh et al. in view of Nelson. As discussed above, Marsh et al. does not disclose all of the limitations of claim 12 because Marsh et al. does not teach or suggest a release tab extending from the perimeter of the main body as required by claim 12. Further, claim 12 requires that the release tab has a length parallel to the main body length and less than the main body length and a width parallel to the main body width and less than the main body width. The release tab shown in Nelson, see FIG. 2, may have a length parallel and less than the main body length, but Nelson does not show a release tab with a width parallel and less than the main body width. The tab's width in Nelson is equal to the main body width.

Therefore, even with a combination of Marsh et al. and Nelson, not all of the claim limitations of claim 12 are taught or suggested. Further, even with the additional element of dependent claim 18, not all of the claim limitations are taught or suggested by a combination of Marsh et al. in view of Nelson. Therefore, dependent claim 18 is not made obvious by Marsh et al. in view of Nelson.

Claims 20 and 21 depend from claim 19. As discussed above, Marsh et al does not disclose a substrate comprising a first side and a second side, wherein the first side has an engagement portion and a single release tab portion where the adhesive layer covers the engagement portion. Nelson also does not teach or suggest a single release tab, but shows two release tabs.

Therefore, even with the additional elements of claims 20 and 21, not all of the claim limitations are taught or suggested by a combination of Marsh et al. and Nelson. Therefore, dependent claims 20 and 21 are not made obvious by a combination of Marsh et al. and Nelson.

C. Marsh et al. in view of Cosenza

Dependent claim 10 includes all of the limitations of claim 1. As discussed above, Marsh et al. does not disclose all of the limitations of claim 1 because Marsh et al. does not teach or suggest a single release tab covered with a tab liner extending from the engagement side and the backing side for removing the engagement side from the surface. Cosenza also does not teach

or suggest the single release tab covered with a tab liner as required by claim 1. Therefore, even with the additional element of claim 10, not all of the claim limitations are taught or suggested by Marsh et al. in view of Cosenza, such that dependent claim 10 is not made obvious by a combination of Marsh et al. and Cosenza.

Dependent claim 15 include the limitation of claim 12, and is not made obvious by Marsh et al. in view of Cosenza. As discussed above, Marsh et al. does not disclose all of the limitations of claim 12 because Marsh et al. does not teach or suggest a release tab extending from the perimeter of the main body as required by claim 12. Cosenza also does not teach or suggest a release tab extending from the perimeter of the main body as required by claim 12.

Therefore, even with a combination of Marsh et al. and Cosenza, not all of the claim limitations of claim 12 are taught or suggested. Further, even with the additional element of dependent claim 15, not all of the claim limitations are taught or suggested by a combination of Marsh et al. in view of Cosenza. Therefore, dependent claim 15 is not made obvious by Marsh et al. in view of Cosenza.

D. Marsh et al. in view of Nelson and further in view of Cosenza

Claim 22 depends from claim 19. As discussed above, Marsh et al. does not disclose a substrate comprising a first side and a second side, wherein the first side has an engagement portion and a single release tab portion where the adhesive layer covers the engagement portion. Nelson also does not teach or suggest a single release tab, but shows two release tabs and Cosenza does not teach any kind of a release tab.

Therefore, even with the additional elements of claim 22, not all of the claim limitations are taught or suggested by a combination of Marsh et al., Nelson, and Cosenza. Dependent claim 22 is not made obvious by a combination of Marsh et al., Nelson, and Cosenza.

First Named Inventor: Melvin Lee Jacobson

Application No.: 10/764,224

-15-

Applicant believes that the above amendments and remarks place pending claims 1-29 of this application in condition for allowance. Therefore, applicant respectfully requests a Notice of Allowance.

Respectfully submitted,

KINNEY & LANGE P.A.

Date: 9/27/2004

By


Trisha D. Adamson, Reg. No. 55,860
THE KINNEY & LANGE BUILDING
312 South Third Street
Minneapolis, MN 55415-1002
Telephone: (612) 339-1863
Fax: (612) 339-6580

TDA:hlw